

SEP 25 2007

Attorney Docket No. P67772US1

Application No. 10/509,950

Remarks/Arguments:

Claims 11-15, 17-26, 30, and 31 are pending, with claims 11, 12, and 21-26 being withdrawn pursuant to restriction.

Claims 1-10, 16, 27, and 28 are cancelled, without prejudice or disclaimer.

Claims 13-15, 17-20, 30, and 31 are currently amended: (1) by limiting the recited "sample" to "a sample of temporal cortex, frontal cortex, and/or hippocampus" (claims 13-15, 17-20, 30, and 31), as described in the paragraph bridging pages 27 and 28 of the subject application, and (2) by inserting the sequence identifier "SEQ ID NO: 1" immediately following the recited "hTARPP," each occurrence, as described in the paragraph bridging pages 9 and 10 of the subject application (claims 13-15, 18-20, and 31). Other amendments to the claims are made to be commensurate with the aforesaid amendments.

Claims 13-15, 17-20, 30, and 31 were rejected under 35 USC 112, first paragraph, for allegedly lacking enablement. Reconsideration is requested in view of the foregoing amendments to the claims, taken in conjunction with the following remarks.

According to the statement of rejection (Office Action, page 6):

Applicant it is advise that claim 13, if limited to methods of diagnosing Alzheimer's disease by determining the levels of nucleic acid encoding hTARPP protein (as a ratio) in specific areas of human brain, as described in the instant specification, would be considered enabled.

Applicants have incorporated the examiner's kind advice, to a limited extent.

As indicated, above, the remaining examined claims are limited to a patient "sample" taken from the "temporal cortex, frontal cortex, and/or hippocampus" areas of the brain. The present

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claims retain, however, making a determination with respect to the "activity"—as well as the "level"—and the "transcription product" (mRNA) of the hTARPP-protein gene—as well as the protein, i.e., the "translation product" of the gene. Applicants submit that enablement under §112, ¶1, is satisfied for the present claims, so limited.

In this respect, attention is directed to the remarks (below) addressing the rejection under §112, ¶2, showing that the subject application provides a definition for the term "activity" as recited in the context of the present claims.

For the foregoing reasons, the rejection under §112, ¶1, for alleged lack of enablement is overcome. Withdrawal of the rejection appears to be in order.

Claims 9, 10, 13-15, 17-20, 30, and 31 were rejected under 35 USC 112, second paragraph, as allegedly being indefinite. Reconsideration is requested.

As applied against claims 9 and 10, the rejection is rendered moot by cancellation of the rejected claims, hereby.

As applied to the remaining rejected claims, the rejection is overcome by inserting the sequence identifier "SEQ ID NO: 1" immediately following the term "hTARPP," as indicated above. According to the statement of rejection, it appears that this overcomes the rejection as applied against claims 13-15, 17-20, 30, and 31.

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As, further, applied against claims 13-15 and 17-20, the statement of rejection alleges (Office Action, page 7) "the instant specification fails to provide any information regarding specific activity of hTARPP protein." Applicants submit that the statement of rejection is mistaken.

With respect to the claim term "activity" the instant specification (page 6, lines 6-9) teaches:

The term "activity" as used herein shall be understood as a measure for the ability of a transcription product or a translation product to produce a biological effect or a measure for a level of biologically active molecules. The term "activity" also refers to enzymatic activity.

Attention is also directed to disclosure in the paragraphs bridging pages 3-5 of the instant specification.

Thus, given the specification definition (above) the term "activity"— used in the context of the rejected claims—means a measure for the ability of the transcription and translation products of the gene coding for hTARPP (SEQ ID NO: 1) to produce a biological effect, e.g., an enzymatic effect. This is the meaning the PTO must use in construing the claims for purposes of examination.

In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989).

When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant's invention and its relation to the prior art.

Zletz, 13 USPQ2d at 1322.

For the foregoing reasons the rejection under §112, ¶2, is overcome. Withdrawal of the rejection appears to be in order.

The objection to claims 9 and 10 for allegedly claiming the same invention, the rejection of claim 4 under 35 USC 102(e), and the rejection of claims 1-10, 27, and 28 under 35 USC 102(b) are

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all rendered moot by cancellation of the rejected claims, hereby. Withdrawal of the rejections appears to be in order.

Request for Examiner's Initialed Form PTO 1449

According to the Office Action the examiner declined to consider reference AE listed on the Form PTO 1449, of record, because it was insufficiently identified. Compliance with "37 CFR (b)(5)"— whatever Rule this is intended to mean—is necessary, according to the instant Office Action.

Provided herewith is a new Form PTO 1449, listing the reference at issue identified the same way that a reference—from the same publication source—is identified (by the PTO) on the face of U.S. Patent No. 7,2717,524 (copy of cover page provided herewith). Since the identification of the reference on the face of the issued patent is, of necessity, in compliance with governing PTO Rules, the identification of the reference on the Form PTO 1449 (provided herewith) is, also, in compliance with governing PTO Rules.

Accordingly, the examiner is requested to mark and initial the provided Form PTO 1449 to show that the reference at issue was considered and return the initialed Form so marked to applicants' undersigned representatives.

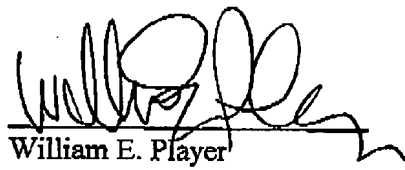
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Favorable action is requested.

Respectfully submitted,

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